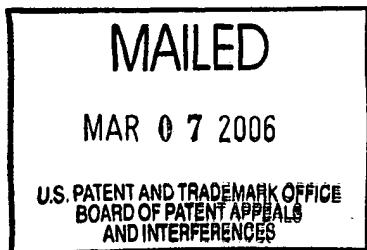


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY MAURICE FLOW
and
FARROKH E. POURMIRZALE

Application 09/922,201

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on January 30, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

A review of the Image File Wrapper (IFW) indicates that in the Final Rejection mailed February 8, 2005, the following rejections were made:

1. Claims 1-5, 8-10, 30 and 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter [page 2];

2. Claims 1-5, 8, 9, 11-16, 19-20, 22-26 and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Rakavy et al (U.S. 5,913,040) [page 4]; and
3. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rakavy et al (U.S. 5,913,040) in view of Smith (U.S. 6,615,248) [page 7].

Appellants reiterated these grounds of rejection on page 4 of their Appeal Brief filed March 29, 2005. In the Examiner's Answer mailed June 28, 2005, however, the examiner lists the following rejections:

1. Claims 1, 2, 4, 8-12, 14, 16, 19-22, 26, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Rakavy et al. (U.S. 5,913,040) [page 2];¹ and
2. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rakavy et al. (U.S. 5,913,040) in view of Smith (U.S. 6,615,248) [page 4].

It appears that the § 102(b) rejection of claims 1, 2, 4, 8-12, 14, 16, 19-22, 26, 29 and 30 listed above is a new ground of rejection because claims 10 and 21 were not initially included in this rejection. If this rejection is to remain, the examiner

¹ It should be noted that the Amendment After Final Rejection filed February 27, 2005 cancelled claims 3, 5, 13, 15, 23-25, 27, 28 and 31.

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must follow the guidelines set forth in training material entitled "Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule," located at the following URL:

www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html

The requirements for a new ground of rejection are:

- 1) Approval by a Technology Center Director or designee; and
- 2) Prominently identified, by a separate heading with all capital letters in the following sections of the Examiner's Answer:

Grounds of Rejection to be Reviewed on Appeal section, and

Grounds of Rejection section.

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed June 28, 2005. Once the Examiner's Answer mailed June 28, 2005 is vacated, the examiner has the following options:

- 1) to write a new Examiner's Answer without the new grounds of rejection;
- 2) to reopen prosecution; or

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3) to write a new Examiner's Answer properly setting forth the new grounds of rejection.

Accordingly, it is

ORDERED that the application is returned to the examiner to:

1) vacate the Examiner's Answer mailed June 28, 2005;

2) to select one of the following options:

a) reopen prosecution;

b) write a new Examiner's Answer without the new grounds of rejection; or

c) write a new Examiner's Answer properly setting forth the new ground of rejection; and

3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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